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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Universal Interactive, Inc.

Serial No. 78377319

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Tuttle LLP for Universal Interactive, Inc.

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Before Hairston, Drost, and Zervas, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Applicant Universal Interactive, Inc. applied to
register the mark SPYRO, in standard character form, on the
Principal Register, for goods ultimately identified as
follows:

Computer game software; pre-recorded motion pictures
featuring animated characters; pre-recorded audio
cassettes, video cassettes, DVD's, CD's and CD-ROM's
featuring musical scores and dialog; entertainment
software in the nature of a game capable of being
played on a television gaming system or portable
gaming system; electronic publications, namely
downloadable newsletters, magazines and catalogues;
photographic cameras; radios; sunglasses; decorative

magnets; video games cartridges, video game cassettes in Class 9.

The application (Serial No. 78377319), was filed on March 2, 2004 and it is based on applicant's allegation of dates of first use anywhere and in commerce of March 11, 1999.

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of Registration No. 1,394,710 for the identical mark SPYRO, in standard character or typed form, for "computer software, namely, programs recorded on magnetic media, and user manuals sold therewith" in Class 9. The registration issued May 27, 1986, and affidavits under Section 8 and 15 have been accepted or acknowledged. The examining attorney has also required that applicant amend its identification of goods and specify the subject matter of its "electronic publications, namely downloadable newsletters, magazines and catalogues."

We address the issue of likelihood of confusion by looking at the evidence in light of the factors set out in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). We point out that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential

characteristics of the goods [or services] and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first compare the marks and we find that they are obviously identical. Both applicant's and registrant's marks are for the same word, SPYRO, in typed or standard character form. This is a significant factor in our likelihood of confusion analysis. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

The next factor we consider is the relationship between applicant's and registrant's goods. Registrant's goods are broadly identified as computer software, namely, programs recorded on magnetic media, and user manuals sold therewith. Registrant's goods are not limited to any particular type of computer software. Applicant's goods include computer game software and entertainment software in the nature of a game capable of being played on a television gaming system or portable gaming system, video games cartridges, and video game cassettes.

When we consider the relatedness of the goods, our analysis is premised on a comparison of the goods as they

are set out in the application's and registrant's identification of goods. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) ("Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be").

Furthermore, the board has previously addressed the specific issue of the likelihood of confusion between broadly defined computer goods in a registration and the same goods that are limited by subject matter in an application.

Registrant's goods are broadly identified as computer programs recorded on magnetic disks, without any limitation as to the kind of programs or the field of use. Therefore, we must assume that registrant's goods encompass all such computer programs including those which are for data integration and transfer. We must also assume that they would travel in the same channels of trade normal for those goods and to all classes of prospective purchasers for those goods. In

re Elbaum, 211 USPQ 639 (TTAB 1981). So viewed, we agree with the Examining Attorney that registrant's goods encompass applicant's computer programs.

In re Linkvest S.A., 24 USPQ2d 1716, 1716 (TTAB 1992). See also In re N.A.D. Inc., 57 USPQ2d 1872, 1874 (TTAB 2000)

("Registrant's goods are broadly identified as computer programs recorded on tapes or disks, without any limitation as to the kind of programs or the field of use.

Accordingly, we must assume that registrant's goods encompass all such computer programs including those which may be intended for the medical field"). These cases are, of course, consistent with the general principle that we do not read limitations into the identification of goods.

Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940

(Fed. Cir. 1983)("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration").

Consistent with these cases, we must assume that registrant's computer software includes computer game software. Thus, we find that applicant's goods are in part identical because they both include computer game software. In addition, inasmuch as applicant's goods include entertainment software in the nature of a game capable of

being played on a television gaming system or portable gaming system, video games cartridges, and video game cassettes, they would be closely related to registrant's computer software.

In its response to the first Office action (p.9), applicant argued that:

In its own words, registrant "provides all or part of the services for basic detail engineering, procurement, construction and project management, at optimized costs. The Group has a long track record in implementing large turnkey contracts and arranging related international financing on behalf of its clients. In particular, in the offshore segment, Technip is in a position to fulfill the expectations of operators, wanting to entrust the largest possible range of services to a single contractor able to manage all aspects of a major field development."

In its appeal brief (p.2), applicant argues that registrant's software is "used in the field of producing ethylene (construction and expansion of steam crackers) in the engineering and petrochemical industries." Applicant's computer game software would be different from the software applicant attributes to the registrant. However, as noted above, we do not read limitations into the identification of goods.¹ Quite simply, an applicant cannot produce the

¹ We note at this point that applicant refers to an Exhibit A in its appeal brief that is apparently a brochure of registrant. We agree with the examining attorney that, if this is the first time the brochure was introduced into the record, it is untimely. 37 CFR § 2.142(d). USPTO electronic and paper records for this appeal do not indicate that the brochure was attached to applicant's brief. However, applicant's own description of the

registrant's literature and thereby limit the scope of its identification of goods.²

Furthermore, because of the identical or otherwise highly related nature of the goods, we must assume that the channels of trade and purchasers are the same. Genesco Inc. v. Martz, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

record and the case law indicates that it would not be relevant because we must rely on the registration's identification of goods and not the registrant's promotional literature.

² Simultaneously with its appeal brief, applicant submitted a request for remand to amend its identification of goods. The request was denied because applicant did not show good cause for the remand. Order dated September 22, 2005. The examining attorney was advised in the Order at 2 that the appeal would proceed on the basis of the current identification of goods "[u]nless the Examining Attorney wishes to accept the proposed amendment." Inasmuch as applicant's request for remand was denied and the examining attorney has not accepted the proposed amendment, we do not address the late-filed amendment to the identification of goods.

We now address other issues and arguments that are relevant to this case. Applicant argues that (Brief 2):

Because [registrant's] goods description is grossly overbroad and violates TMEP § 1402.03(d), the likelihood of confusion analysis should more heavily take into account registrant's actual use of its mark, which is very different from Applicant's use.

As the examining attorney indicated (Brief at unnumbered pages 5-6), the cited registration issued in 1986 prior to the Linkvest case. Therefore, the fact that examining attorneys today would require a more specific identification of goods does not effect the identification of goods that was approved twenty years ago. We also add that applicant is not permitted to attack the validity of a registration cited against it or to require the board to read limitations into the registration's identification of goods.

Dixie's argument that DELTA is not actually used in connection with restaurant services amounts to a thinly-veiled collateral attack on the validity of the registration. It is true that a prima facie presumption of validity may be rebutted. See Dan Robbins & Assocs., Inc. v. Questor Corp., 599 F.2d 1009, 1014, 202 USPQ 100, 105 (CCPA 1979). However, the present ex parte proceeding is not the proper forum for such a challenge. Id. ("One seeking cancellation must rebut [the prima facie] presumption by a preponderance of the evidence."); Cosmetically Yours, Inc. v. Clairol Inc., 424 F.2d 1385, 1387, 165 USPQ 515, 517 (CCPA 1970); TMEP Section 1207.01(c)(v) (1993); 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* Section 23.24[1][c] (3d ed. 1996). In fact, Cosmetically Yours held that "it is not open to an applicant to prove abandonment of [a]

registered mark" in an ex parte registration proceeding; thus, the "appellant's argument ... that [a registrant] no longer uses the registered mark ... must be disregarded." 424 F.2d at 1387, 165 USPQ at 517; cf. In re Calgon Corp., 435 F.2d 596, 598, 168 USPQ 278, 280 (CCPA 1971) (applicant's argument that its use antedated a registered mark was effectively an improper collateral attack on the validity of the registration, which should have been made in formal cancellation proceedings).

Dixie claims that it is not arguing that the DELTA mark has been abandoned, only that it has not been used for restaurant services, so there is no likelihood of confusion. However, unless it establishes abandonment, the registration is valid, and we must give effect to its identification of services. Cosmetically Yours, 424 F.2d at 1387, 165 USPQ at 517 ("As long as the registration relied upon ... remains uncanceled, it is treated as valid and entitled to the statutory presumptions.").

Dixie Restaurants, 41 USPQ2d at 1534-35. See also Squirtco v. Tomy Corp., 216 USPQ at 940. Therefore, we will not limit the registration's identification of goods.

At this point, it is important to emphasize that an applicant faced with a cited registration with a broad identification of goods:

[I]s not without remedies in its attempt to obtain a registration. Applicant may, of course, seek a consent from the owner of the cited registrations, or applicant may seek a restriction under Section 18 of the Trademark Act, 15 U.S.C. § 1068. This remedy is available for those who believe that a restriction in the cited registration(s) may serve to avoid a likelihood of confusion. See Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, 34 USPQ2d 1266 (TTAB 1994). Compare Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992)(no likelihood of confusion between specifically identified computer services and programs in different fields-computer

data processing programming/information management services and computer programs for electrical distribution system analysis and design).

N.A.D., 57 USPQ2d at 1874.

Section 18 (15 U.S.C. § 1068) specifically permits the Office in opposition and cancellation proceedings to "modify the application or registration by limiting the goods or services specified therein."

Another argument applicant makes is that "it appears that both marks have been used in the marketplace for years without conflict... This conflict-free period of coexistence weighs further in favor of no likelihood of confusion."

Brief at 3. However, the lack of actual confusion is seldom decisive in ex parte proceedings.

With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See In re Bissett-Berman Corp., 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, J.C. Hall Co. v. Hallmark Cards, Inc., 52 CCPA 981, 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965), especially in an ex parte context.

In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). In this ex parte case, we

have no indication of what the registrant's views and evidence on this issue would be, and we similarly give applicant's assertion of no actual confusion little weight.

Furthermore, we do not give the applicant the benefit of the doubt in likelihood of confusion cases, as applicant asserts. Indeed, case law dictates that we resolve doubt in favor of the registrant. In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

On the issue of likelihood of confusion, we conclude that when the identical marks are used on goods that overlap and are otherwise highly related, there is a likelihood of confusion and we affirm the examining attorney's refusal to register.

Regarding the examining attorney's requirement that applicant specify the subject matter of applicant's electronic publications, namely downloadable newsletters, magazines and catalogues, we likewise affirm this requirement. Applicant has not addressed this requirement in its brief. Even in its request for remand to consider an amendment to the identification of goods, applicant did not propose to amend the "electronic publications" portion

of its identification of goods. By failing to assert any error regarding this requirement, we consider that applicant has conceded this point. TBMP § 1203.02(g) (2d ed. rev. 2004). Even if applicant has not conceded this point, we note that the Office requires the subject matter of publications be set out in the identification of goods. TMPE § 1402.03(b) (4th ed. April 2005):

When the goods are publications, the identification must indicate both the specific physical nature and the literary subject matter of the publication.

Example - "Magazine devoted to medicine" is acceptable.

Example - "Television programming newsletter" is acceptable.

In the case of printed matter of a specialized nature, the identification should describe the goods by specific names or wording that explains their specialized nature.

Example - "Children's storybooks" is acceptable.

Even if the mark itself indicates the subject of a publication, the identification must specify the subject matter.

Without this information, the exact point that applicant complains about concerning the registrant's computer software would occur with publications, i.e., publications would appear to be identical to the extent that they were identified simply as "magazines" regardless of their subject matter. Inasmuch as applicant's current identification of goods would include a wide variety of

publications on numerous subjects that applicant is not publishing, the current identification of goods is indefinite.³ In re Air Products & Chemicals, Inc., 192 USPQ 84, 85 (TTAB 1976), recon. denied, 192 USPQ 157 (TTAB 1976) ("It is common knowledge that 'catalysts' encompass a wide range of products and that there are catalysts which are used for a large variety of catalytic and chemical processes. Thus, the present identification could conceivably include a large number of catalysts which applicant does not manufacture. Under such circumstances, to allow applicant to register its mark for so broad an identification of goods would give it a scope of protection to which it is not entitled").

Decision: The examining attorney's refusals to register are affirmed.

³ The examining attorney had suggested the following identification of goods: "electronic publications, namely, downloadable newsletters, magazines and catalogues featuring animated cartoon characters and information about computer and video games."